

1626/1A



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mitchell A. Avery  
Appl. No.: 09/981,312  
Filed: October 15, 2001  
Confirmation No.: 4970  
Docket No.: 1786  
Title: **SYNTHESIS OF EPOTHILONES AND RELATED ANALOGS**  
Art Unit: 1626  
Examiner: Fiona Powers  
Action: **RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE**  
Date: March 24, 2004

TO: Mail Stop Non-Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated September 24, 2003, please reconsider the restriction requirement set forth therein in light of the following remarks.

**REMARKS**

The Examiner has set a shortened statutory period for response to this action to expire one (1) month from the mailing date of the communication. Filed concurrently herewith is a request for a fifth month extension of time so that the present reply is due by March 24, 2004.

In the Office Action, claims 1-34 and 69-72, 74-78 were pending as the result of a previous restriction requirement dated January 15, 2003. In the present Office Action, the Examiner withdrew claims 75-78 from consideration as "being drawn to independent and distinct inventions from the elected group I." Accordingly, the present restriction requirement pertains to claims 1-34, 69-72 and 74.

Turning to the Office Action, then, the Examiner has taken the position that "generic claim 1 ... encompasses various moieties for W, which have acquired a separate status in the art." The Examiner asserts "the search required, both

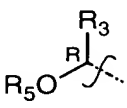
electronic and manual database, for each of the patentably distinct species is separate and involves separate search considerations and search strategies". As a result, the Examiner maintains that "a serious burden would be placed on the office if restriction within these generic claims were not required."

Section 121 of Title 35 of the U.S. Code authorizes the Commissioner of Patents and Trademarks to require restriction if "two or more independent and distinct inventions are claimed in one application". The Office defines "distinct" as meaning "related", but "capable of separate manufacture, use or sale as claimed AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)." MPEP § 802.01.

Pursuant to 37 C.F.R. § 1.141 and MPEP § 806.04(a), Applicant is entitled to claim a reasonable number of species in one application. Applicant asserts that the number of species in the present set of claims is reasonable and respectfully suggests that a consolidated examination of the species would not be burdensome. Moreover, the Applicant should not be placed in a position to shoulder the burden of what may likely turn into approximately a dozen patent filings, a dozen patent prosecutions, and a dozen sets of maintenance fees to obtain protection for the subject matter of the original set of claims. Accordingly, it is requested that the examiner reconsider her present species restriction requirement.

Nonetheless, in accordance with 37 C.F.R. § 1.143, Applicant acknowledges that a proper reply to the Examiner's restriction requirement is not complete unless a species election is made. During the telephone conversation courteously extended by the newly assigned Examiner to Applicant's representative, Rebecca A. Gegick on March 22, 2004, a proper species election was discussed. Applicant's representative noted that there appeared to be a typographical error on page 3,

paragraph 3 of the Restriction Requirement because generic claim 1 does not define moieties by the symbol "W". Accordingly, it was determined that "W" was intended to be "A". With this in mind, then, Applicant elects to proceed with the species wherein

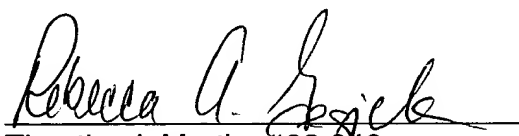
"A" in claim 1 is defined as 

Applicant believes that this communication is fully responsive to the Restriction Requirement dated September 24, 2003 and that no new fees are due. However, the Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment respecting this response to Deposit Account No. 13-1940.

If there are any further issues regarding the above-identified patent application, it is respectfully requested that the Examiner contact the undersigned attorney for the Applicant at the number listed below.

Respectfully submitted,

***TIMOTHY J. MARTIN, P.C.***



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